

# Notice of Allowability

Application No.

09/407,605

Examiner

Chih-Min Kam

Applicant(s)

MILLER ET AL.

Art Unit

1653

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 8/9/04.
2. ☒ The allowed claim(s) is/are 81-94,96-108 and 110-112.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
  1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☒ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☒ to Paper No./Mail Date 3/29/01.
    - (b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date 20041025.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date 20041025.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

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An **Examiner's Amendment** to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Todd Garcia on October 25, 2004.

**Examiner's Amendments to the Claims:**

Claims 81, 85, 89, 97, 100 and 103 have been amended as follows:

81. (Currently amended) A synthetic nucleic acid sequence which encodes a human Factor VIII or [a functional portion thereof], wherein at least one non-common codon or less-common codon has been replaced by a common codon encoding the same amino acid residue as the non-common or less-common codon and wherein the synthetic nucleic acid has a continuous stretch of at least 150 codons all of which are common codons, and wherein by a common codon is meant the most common codon encoding each particular amino acid residue in highly expressed human genes as shown in Figures 14A[-] and 14B.

85. (Currently amended) A synthetic nucleic acid sequence which encodes a human Factor VIII [or a functional portion thereof], wherein at least one non-common codon or less-common codon has been replaced by a common codon encoding the same amino acid residue as the non-common or less-common codon and wherein the synthetic nucleic acid has a continuous stretch of common codons which comprise at least 60% of the codons of the synthetic nucleic acid sequence, and wherein by a common codon is meant the most common codon encoding each particular amino acid residue in highly expressed human genes as shown in Figures 14A[-] and 14B.

89. (Currently amended) A synthetic nucleic acid sequence which encodes a human Factor VIII [or a functional portion thereof], wherein at least one non-common codon or less-common codon has been replaced by a common codon encoding the same amino acid residue as the non-common or less-common codon and wherein at least 98% or more of the codons in the sequence encoding the Factor VIII are common codons and the Factor VIII is at least 90 amino

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acid residues in length, and wherein by a common codon is meant the most common codon encoding each particular amino acid residue in highly expressed human genes as shown in Figures 14A[-] and 14B.

97. (Currently amended) A synthetic nucleic acid sequence which encodes human Factor IX, wherein at least one non-common codon or less-common codon has been replaced by a common codon encoding the same amino acid residue as the non-common or less-common codon and wherein the synthetic nucleic acid has a continuous stretch of at least 150 codons all of which are common codons, and wherein by a common codon is meant the most common codon encoding each particular amino acid residue in highly expressed human genes as shown in Figures 14A[-] and 14B.

100. (Currently amended) A synthetic nucleic acid sequence which encodes human Factor IX, wherein at least one non-common codon or less-common codon has been replaced by a common codon encoding the same amino acid residue as the non-common or less-common codon and wherein the synthetic nucleic acid has a continuous stretch of common codons which comprise at least 60% of the codons of the synthetic nucleic acid sequence, and wherein by a common codon is meant the most common codon encoding each particular amino acid residue in highly expressed human genes as shown in Figures 14A[-] and 14B.

103. (Currently amended) A synthetic nucleic acid sequence which encodes human Factor IX, wherein at least one non-common codon or less-common codon has been replaced by a common codon encoding the same amino acid residue as the non-common or less-common codon and wherein at least 98% or more of the codons in the sequence encoding the Factor IX are common codons and the Factor IX is at least 90 amino acid residues in length, and wherein by a common codon is meant the most common codon encoding each particular amino acid residue in highly expressed human genes as shown in Figures 14A[-] and 14B.

### **Objection to Drawings**

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Figures 14A and 14B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. The objection to the drawings will not be held in abeyance.

The following is an **Examiner's Statement of Reasons for Allowance**: The following reference appears to be the closest art to the claimed invention. Seed *et al.* teach a synthetic gene encoding a protein such as factor VIII normally expressed in a mammalian cell or other eukaryotic cells, wherein at least one non-preferred or less preferred codon in the normal gene encoding the protein has been replaced by a preferred codon encoding the same amino acid, where the preferred codon is indicated in the highly expressed human genes; and at least 10%, 20%, 30%, 40%, 50%, 60%, 70%, 80% or 90% of the non-preferred codons in the natural gene are replaced with preferred codons. However, Seed *et al.* do not disclose the synthetic nucleic acid having a continuous stretch of at least 150 common codons or of 60% of the codons of the synthetic nucleic acid sequence, or at least 98% or more of the codons in the sequence encoding the protein (e.g., factor VIII or factor IX) are common codons, and the protein is at least 90 amino acid residues in length. Therefore, the claims are allowable over the art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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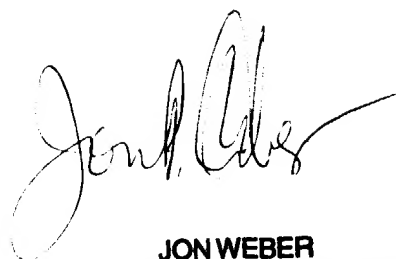
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Chih-Min Kam, Ph. D.  
Patent Examiner

CMK

CMK  
October 25, 2004

A handwritten signature in black ink, appearing to read "Jon Weber", with a stylized, flowing script.

**JON WEBER**  
**SUPERVISORY PATENT EXAMINER**